

### REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-14.

The following claims are *independent*: 1, 5, 10, 13.

The following claims have previously been *cancelled* without prejudice or disclaimer: 15.

### **Claim Rejections - 35 U.S.C. § 103**

The Office Action rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Farnham et al., US Patent No. 7,167,910 (hereinafter “Farnham”), and in further view of Daniell, US Publication No. 2004/0158611 (hereinafter “Daniell”). It should be noted that Farnham was filed June 4, 2002, which is less than ten months earlier than Applicants' earliest priority date of March 14, 2003 and it is not conceded that Farnham was filed in the US before the invention by the Applicants. It should also be noted that Daniell was filed February 10, 2003, which is less than five weeks earlier than Applicants' earliest priority date of March 14, 2003 and it is not conceded that Daniell was filed in the US before the invention by the Applicants. Without so conceding, Applicants respectfully traverse the rejections and submit that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,

(iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

(iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements.

Independent claim 1 recites, *inter alia*,

1. A computer-implemented method for managing risk through link analysis mapping, the method comprising:

...

receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation;

...

outputting for utilization in risk management an indication of the link associating the identified person with the one or more other persons with the predefined specified number of degrees of separation and an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons.

Applicant submits that the applied references, taken alone or in combination, do not discuss or render obvious at least these elements recited in independent claim 1.

The pending rejection alleges,

"Farnham teaches a system and a method comprising: ... receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation (Figure 1, elements 110, 112, 114 and 116, wherein a social map/network can be created based on adjusted groupings, in particular the lowest degree of separation includes individuals with whom at least a predetermined number of email correspondence was exchanged (column 4, lines 62-67 and column 5, lines 1-4));..." (See, June 15, 2009 Office Action, pages 2-3).

The pending rejection also notes that Farnham "does not explicitly teach that an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons" (See, June 15, 2009 Office Action, page 3). However, the Examiner then alleges that this deficiency of Farnham is remedied by Daniell, which the Examiner asserts,

"teaches a system for displaying social network in a form of a Instant Messenger list wherein a main user can easily view which of his/her friends from the social network are online and which one are offline (i.e. indication of disconnect indicating separation in time because those individuals are currently unavailable) (paragraph [0062], and also illustrated in figure 7)." (See, June 15, 2009 Office Action, page 3).

Applicants respectfully traverse these arguments and submit that the Office Action mischaracterizes claim components and/or aspects of Farnham and Daniell. More specifically, Applicants disagree with the reasoning provided in the "Response to Arguments" section of the Office Action, in paragraphs 15, 14, 7-10 and 11-12.

In paragraph 15 of the Office Action, the Examiner alleges that "the Applicant simply speculates whether one of ordinary skill in the art could or could not determine if it is obvious to modify Farnham's teaching based on Daniell's disclosure. On contrary to the Applicant's allegation, the Examiner maintains that indeed one of ordinary skill in the art would consider it obvious to modify Farnham's teaching with Daniell's." (See, June 15, 2009 Office Action, page 7). MPEP § 2141 (II)(C) states, "**Any obviousness rejection should include**, either explicitly or implicitly in view of the prior art applied, **an indication of the level of ordinary skill.**" (emphasis added). The pending rejection refers to, "one of ordinary skill in the art," (e.g., June 15, 2009 Office Action, p. 7) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith.

The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter.

In paragraph 14 of the Office Action, the Examiner argues that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But **so long as it takes into account only knowledge which was within the level of ordinary skill** at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper." (emphasis added) (See, June 15, 2009 Office Action, page 7). MPEP § 2141.03 (III) states, "**The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.**" Applicants submit that objectivity has not been maintained and that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants submit that a *prima facie* showing of obviousness has not been made. Should the Examiner maintain the rejection, Applicants respectfully request that the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how and specifically why the Examiner believes the claimed subject matter would have been obvious to one possessing that level of skill.

In paragraph 8 of the Office Action, the Examiner alleges that "the number of email sent and received indicates how much correspondence individuals exchange. Thus, more frequent correspondence would translate to lower degree of separation, since two individuals are in constant contact. Similarly, if two individuals barely exchange emails, they are most likely not very close too each other, hence the degree of separation would be higher. Moreover Farnham teaches that the social network can be limited by number of occurrences (i.e. number of correspondence exchanged), and this in fact is interpreted as a specifying degree of separation." (See, June 15, 2009 Office Action, page 5).

Applicants respectfully traverse this argument and submit that nowhere in Farnham is there any mention of "degrees of separation," let alone discussion, of "receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation," as recited in independent claim 1. Applicants contend that the Examiner is reading in "degrees of separation" into Farnham where there is no concept of "degrees of separation." Instead, Farnham discusses "that the computer communication information is filtered according to one or more preselected criteria, so that the number of people (i.e., contacts) associated with the selected user may be reduced if the number is excessive." (Farnham, col. 4, lines 48-52). In Farnham, some number of "people with the greatest number of occurrences may be selected for inclusion" into a user's contacts where "the number of occurrences for each individual is the number of times that person appears as a recipient or sender of an email." (Farnham, col. 4, lines 63-67 and col. 5, line 1). However, Applicants submit that mere counting of "the number of occurrences" (Farnham, col. 4, lines 63-64) is not equivalent to "degrees of separation," much less "receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation," as recited in independent claim 1. Furthermore, Farnham's use of "the number of occurrences" to limit "the number of people (i.e., contacts) associated with the selected user," in no way supports the Examiner's mere conclusionary statement that "that the social network can be limited by number of occurrences... is interpreted as a specifying degree of separation." (See, June 15, 2009 Office Action, page 5).

In paragraph 12 of the Office Action, the Examiner alleges that "a colorful indicator signifying whether another person is or is not available to being contacted, certainly can be considered a type of disconnect indicating a separation in time regarding link associating two people (i.e. a user and another

person on a list of contacts). In particular, disconnect is interpreted as unavailability of another person at a particular point in time." (See, June 15, 2009 Office Action, page 6).

Applicants respectfully traverse this argument and submit that the cited portion of Daniell in no way mentions "disconnects," let alone addresses "disconnects... wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons," as recited in independent claim 1. Instead, paragraph [0062] of Daniell discusses "providing presence information.... presence information can be represented as states such as: 1=online-present; 2=online-away; 3=online-extended away; 4=online-do not disturb; and 5=offline: where, a present state indicates the user is available for a chat session." (Daniell, paragraph [0062]). In Daniell, "when a chat message is attempted to be sent between users where a user's presence is state 4 or 5, i.e., online-do not disturb or offline, the chat message will be undeliverable." (Daniell, paragraph [0062]). Daniell's use of indicators "to provide presence information," in no way supports the Examiner's mere conclusionary statement that "a colorful indicator signifying whether another person is or is not available to being contacted, certainly can be considered a type of disconnect indicating a separation in time regarding link associating two people." (See, June 15, 2009 Office Action, page 6).

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words in a claim must be considered in judging the patentability of that claim against the prior art*." [§ 2143.03, emphasis added]. Applicants submit that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). Accordingly, Applicants submit that a

*prima facie* showing of obviousness has not been put forth and respectfully requests reconsideration and withdrawal of this basis of rejection.

Although of different scope than claim 1, Applicants submit that claims 5, 10 and 13 are patentable over Farnham in view of Daniell, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Furthermore, Applicants submit that claims 2-4, 6-9, 11-12 and 14, which depend directly or indirectly from independent claims 1, 5, 10 and 13 respectively, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least the reasons discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

## CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-14, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for

rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicants assert that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserve the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.



**Authorization**

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209\_310. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209\_310.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,  
CHADBOURNE & PARKE LLP

Dated: August 17, 2009

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